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EXAMINER

HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

4/L

Office Action Summary

Application No.

09/713,733

Applicant(s)

KANTROWITZ, MARK

Examiner

Cong-Lac Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-16, 18 and 20-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-16, 18 and 20-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: amendment and declaration filed 10/17/04 to the application filed on 11/15/00.
2. Claims 13, 17, 19 are canceled.
3. Claims 1-12, 14-16, 18, 20-39 are pending in the case. Claims 1, 37, 39 are independent claims.
4. The rejections of claims 15 and 23 under 35 U.S.C. 112, second paragraph, have been withdrawn in view of the amendment.
5. The rejection of claim 19 under 35 U.S.C. 112, second paragraph, has been withdrawn in view of the cancellation of claim 19.
6. The objection of claim 20 as being a substantial duplicate of claim 19 has been withdrawn in view of the amendment.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-2, 10-12, 14-16, 18, 20-21, 26-29, 37-39 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Gomes et al. (US Pat No. 6,615,209 B1, 9/2/03, filed 10/6/00, priority 2/22/00).

Art Unit: 2178

Regarding independent claim 1, Gomes discloses:

- initially, selecting distinctive features contained in the collection of documents
(**col 3, lines 33-43, col 7, lines 43-56**: the query-relevant parts extracted from the documents are distinctive features of the documents since the query-relevant parts includes specific information common to the documents; though Gomes does not explicitly mention the collection of documents, the fact that extracting the query-relevant parts from a plurality of documents suggests that these documents are in a collection for extracting)
- for each pair of documents having at least one distinctive features in common, comparing the distinctive features of the documents to determine whether the document are duplicate or near-duplicate document (**col 3, line 33 to col 4, line 10, col 2, lines 38-56, col 7, lines 43-56**: comparing each two documents for similarity based on the query-relevant parts referred as “snippets” where the documents found can be duplicate, or duplicate with slight change, which means near-duplicate)
- wherein the distinctive features are text fragments, which are sequences of at least two words that appear in a limited number of documents in the document collection (**col 7, lines 50-56; col 10, lines 56-67**: the query-relevant information or the segments surrounding keyword occurrences are text fragments from the documents that show distinctive features of the document where it is clear that a text fragment is a sequence of at least two words; since there is only a number of

documents having the text fragments that includes the keywords in the query, not all the documents, the number of said documents is limited)

- wherein the text fragments are determined to be distinctive features based upon a function of the frequency of a text fragment within a document in the large collection of documents (**col 12, lines 18-35**: the fact that a segment may be added to the query-relevant part QR only if it contains at least a *predetermined number of occurrences of any of the keywords* where a segment is a portion of a document shows that the segment is determined to be distinctive features based on the occurrences of keywords, which is equivalent to a text fragment, within a document of a document collection)

Gomes does not explicitly disclose that for each document, identifying the distinctive features contained in the document.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Gomes to include identifying the distinctive features contained in each document since the fact that the query-relevant parts are extracted from the plurality of documents suggests that the query-relevant parts be identified in each document as related data before being extracted.

Regarding claim 2, which is dependent on claim 1, Gomes discloses that the method is applied to removing duplicates in document collections (figure 9, #930, col 8, lines 37-60: the duplicate removal management process uses query-relevant information to extract query-relevant information from documents indicates that Gomes method is

Art Unit: 2178

applied for removing duplicates in a plurality of documents which are document collections).

Regarding claim 10, which is dependent on claim 1, Gomes discloses that the method is applied to creating a document index for use with a query system to efficiently find documents in response to a query which contains a particular phrase or excerpt (col 6, lines 10-27: "...a crawling process gets content from various sources accessible and stores such content...an automated indexing/sorting process may access the stored content and may generate a content index ...a query processing process accepts queries and returns query results based on the content index..."; the returned query results based on the content index suggest that the query contains at least some words of the content index).

Regarding claim 11, which is dependent on claim 10, Gomes discloses that the document index can be utilized even if the particular phrase or excerpt was not recorded correctly in the document or in the query (col 6, lines 10-27: the fact that the queries are accepted and the query result are returned based on the content index suggests the document index can be used no matter how a particular phrase is recorded in the query or document).

Regarding claim 12, which is dependent on claim 1, Gomes discloses that the distinctive features appear in a different order in each of the documents (col 13, lines 1-

Art Unit: 2178

22: "...the word frequencies of the query-relevant part ...two files with the same words *in different orders* would appear to be identical").

Regarding claim 14, which is dependent on claim 1, Gomes discloses that the method is applied to information retrieval methods (col 5, line 66 to col 6, line 2; col 7, lines 28-40).

Regarding claim 15, which is dependent on claim 14, Gomes does not disclose that a text classification method is applied to the information retrieval method. However, it would have been obvious to an ordinary skill in the art at the time of the invention was made to have modified Gomes to include applying a text classification method to the information retrieval method since the process of retrieving information from a database where it was well known that data in the database is typically stored in directories of various topics and types showing a text classifying of documents in the database.

Regarding claim 16, which is dependent on claim 14, Gomes discloses that the information retrieval method assumes word independence, and the distinctive text fragments are added to an index set (col 6, lines 10-27: "...a crawling process gets content from various sources accessible and stores such content...an automated indexing/sorting process may access the stored content and may *generate a content index* ...a query processing process accepts queries and returns query results based on the content index..."; the returned query results based on the content index suggest that

Art Unit: 2178

the content index contains at least some words of the query that is a distinctive text fragment).

Regarding claim 18, which is dependent on claim 1, Gomes discloses that if one distinctive text fragments is contained within another distinctive text fragment within the same document, only the longest distinctive text fragment is considered as a distinctive feature (col 10, lines 44-67: the fact that segments surrounding keyword occurrences or keyword-in-context summaries suggest that the segment which is considered as the longest distinctive text fragment since it includes the query-related information, which is the shorter distinctive text fragments).

Regarding claim 20, which is dependent on claim 1, Gomes discloses that the sequences of at least two words are considered as appearing in a document when the document contains the sequence of at least two words at least a user-specified minimum frequency (col 12, lines 18-35: the fact that a segment may be added to the query-relevant part QR only if it contains at least a predetermined number of occurrences of any of the keywords where a segment is a portion of a document suggests that the document contains the sequence of keywords and a specified minimum frequency of the occurrences of the keywords where it was obvious that the predetermined number of occurrences can be defined by user).

Regarding claim 21, which is dependent on claim 17, Gomes discloses:

- the highest scoring sequences that are found in at least two documents in the document collection are considered distinctive text fragments (col 12, lines 40-54: the fact that only a predetermined number of the highest ranking segments would be added to the query-relevant part QR suggests the highest ranking segments added to the query-relevant part QR be considered as distinctive text fragments)

Gomes does not explicitly disclose calculating a distinctive score for each sequence of at least two words. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Gomes to include calculating a distinctive score for each sequence of at least two words since once a segment including sequences of words related to the query is ranked as a highest ranking segments, the ranking process must be carried out based on the scores of a plurality of segments. In other words, calculating a score for each sequence of words must be performed for the segment ranking.

Regarding claim 26, which is dependent on claim 17, Gomes does not explicitly disclose that the limited number of documents is selected by a user.

Instead, Gomes discloses that since the amount of text extracted influences a subsequent similarity measure, the tunable parameters 933 and 935 *should be adjusted* in concert (figure 9 and col 10, lines 44-50). Gomes further explains that “in general, the less information extracted, the more similar the documents may be found to be (so the similarity threshold should be set higher, or stated oppositely, the more information

extracted, the less similar the documents may be found to be (so the similarity threshold should be set lower)" (col 10, lines 51-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Gomes to include the user's selection for the limited number of documents since the fact a user *can adjust the extraction parameters* or the similarity measure parameters for a desired result suggests a possibility for users to *select the limited number* of documents for the adjustment.

Regarding claim 27, which is dependent on claim 17, Gomes does not explicitly disclose that the limited number is defined by a linear function of the number of documents in the document collection.

However, as mentioned in claim 26 above, Gomes discloses that a user can select the parameters in the program to adjust text extraction and the similarity measure (col 10, lines 44-55).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Gomes to incorporate a linear function of the number of documents based on the adjusted parameters and the number of documents in the document collection.

Regarding claim 28, which is dependent on claim 17, Gomes discloses that the distinctive text fragments include glue words (col 10, line 56 to col 11, line 11: though the keywords preferably do not include the "stop word" or glue word such as "the", "it",

"and", "or", etc. for the search, the keywords are included in the snippets, which are the segments surrounding the keywords; therefore, the segments surrounding the keywords, that are equivalent to the distinctive text fragments, still include glue words).

Regarding claim 29, which is dependent on claim 17, Gomes does not explicitly disclose that the glue words do not appear at either extreme of the distinctive text fragments.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Gomes to include the feature that the glue words do not appear at either extreme of the distinctive text fragments for the following reason. Since the glue words do not convey much information or convey some type of Boolean operations (col 11, lines 1-11), there is no need to include the glue words at the either extreme of the distinctive text fragments.

Regarding independent claim 37 and its dependent claim 38, Gomes discloses:

- initially, selecting distinctive features contained in the collection of documents (col 3, lines 33-43, col 7, lines 43-56: the query-relevant parts extracted from the documents are distinctive features of the documents since the query-relevant parts includes specific information common to the documents; though Gomes does not explicitly mention the collection of documents, the fact that extracting the query-relevant parts from a plurality of documents suggests that these documents are in a collection for extracting)

Art Unit: 2178

- for each pair of documents having at least one distinctive features in common, comparing the distinctive features of the documents to determine whether the document are duplicate or near-duplicate document (col 3, line 33 to col 4, line 10, col 2, lines 38-56, col 7, lines 43-56: comparing each two documents for similarity based on the query-relevant parts referred as “snippets” where the documents found can be duplicate, or duplicate with slight change, which means near-duplicate)
- wherein the distinctive features are text fragments, which are sequences of at least two words that appear in a limited number of documents in the document collection (**col 7, lines 50-56; col 10, lines 56-67**: the query-relevant information or the segments surrounding keyword occurrences are text fragments from the documents that show distinctive features of the document where it is clear that a text fragment is a sequence of at least two words; since there is only a number of documents having the text fragments that includes the keywords in the query, not all the documents, the number of said documents is limited)
- wherein the text fragments are determined to be distinctive features based upon a function of the frequency of a text fragment within a document in the large collection of documents (**col 12, lines 18-35**: the fact that a segment may be added to the query-relevant part QR only if it contains at least a *predetermined number of occurrences of any of the keywords* where a segment is a portion of a document shows that the segment is determined to be distinctive features based

on the occurrences of keywords, which is equivalent to a text fragment, within a document of a document collection)

Gomes does not explicitly disclose that for each document, identifying the distinctive features contained in the document.

However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Gomes to include identifying the distinctive features contained in each document since the fact that the query-relevant parts are extracted from the plurality of documents suggests that the query-relevant parts be identified in each document as related data before being extracted.

Gomes also does not disclose that the method is applied to a collection of text spans where the text spans are sentences. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have utilized identifying duplicates and near-duplicates documents in Gomes to apply to identifying duplicates and near-duplicates text spans where text spans are sentences *since it was obvious that a document comprises a plurality of sentences*. Accordingly, the two documents are identified duplicates if they have the duplicate sentences. Therefore, comparing the distinctive features of the documents should be based on comparing the distinctive features of the text spans, which are sentences included in a document. In other words, Gomes inherently includes identifying duplicate and near-duplicate text spans, which are sentences.

Independent claim 39 is for an apparatus of method claim 1, and is rejected under the same rationale.

9. Claims 3-7, 30 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Gomes as applied to claim 1 above, and further in view of Aiken (US Pat No. 6,240,409 B1, 5/29/01, filed 7/31/98).

Regarding claims 3 and 4, which are dependent on claim 1, Gomes does not disclose explicitly that the method is applied to detecting plagiarism and to detecting copyright infringement.

Aiken discloses a method for detecting the similarities between the two documents (abstract, col 3, lines 4-24) and applying the detecting of similarities for detecting plagiarism among a set of documents and providing copyright protection (col 18, lines 1-22).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Aiken into Gomes for the following reason. Aiken discloses applying the detecting of similarities of documents to detecting plagiarism and providing copyright protection, thus motivating to apply the duplicate determination in Gomes to detecting plagiarism and providing copyright protection since the duplicate features of the two documents in Gomes are the same as the similarities between the documents in Aiken and copyright protection is for preventing of the copyright infringement.

Art Unit: 2178

Regarding claim 5, which is dependent on claim 1, Gomes does not disclose explicitly that the method is applied to determine the authorship of a document.

As mentioned in claims 3-4 above, Aiken discloses applying the detecting of similarities for detecting plagiarism among a set of documents and providing copyright protection (col 18, lines 1-22).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Aiken into Gomes for the following reason. Aiken teaches applying detecting the document similarities to detecting plagiarism and providing copyright protection, thus motivating to determine the authorship of a document, especially the duplicate documents in Gomes since both plagiarism and copyright protection are for confirming the real author of a document.

Regarding claim 6, which is dependent on claim 1, Gomes does not disclose that the method is applied to clustering successive versions of a document from among a collection of documents.

Aiken discloses clustering successive versions of a document from among a collection of documents (figures 1a-b, 4a and col 10, line 4 to col 11, line 46).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Aiken into Gomes since Aiken discloses clustering documents *based on similarities of the document contents* thus motivating to utilize the duplicate and near-duplicate features of documents in Gomes for clustering documents in a collection.

Art Unit: 2178

Regarding claim 7, which is dependent on claim 1, Gomes does not disclose that the method is applied to seeding a text classification or text clustering algorithm with sets of duplicate or near-duplicate.

Aiken discloses clustering documents using a text clustering algorithm based on the matching of the documents in a collection (figures 1a-b, 4a, col 7, lines 17-35).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Aiken into Gomes since Aiken discloses a text clustering algorithm applied on the matched documents in a document collection thus motivating to utilize the duplicate features of documents in Gomes as the matching features of the documents for applying the clustering algorithm.

Regarding claim 30, which is dependent on claim 1, Gomes does not disclose:

- counting the number of distinctive features in common
- wherein determining whether the pair of documents is duplicates or near-duplicates includes the steps of:
 - for each pair of documents, calculating an overlap ratio by dividing the number of distinctive features in common by the smaller of the number of distinctive features per document
 - comparing the overlap ratio to a threshold and if the overlap ratio is greater than the threshold, then the pair of documents are duplicates or near-duplicates, otherwise the pair of documents are not duplicates or near-duplicates

Art Unit: 2178

Aiken discloses a method for clustering documents based on detecting the similarities of the documents (abstract, figures 1a, 4a) where the similarities of each two documents are determined by:

- calculating an overlap ratio by dividing the number of distinctive features in common by the smaller of the number of distinctive features per document (col 11, lines 1-14: "The similarity of two documents is *defined by ratio C/T*, where *C is the number of hashes the two documents have in common* and *T is the total number of hashes taken of one of the documents*, which can be the current document or *the smaller document...*")
- counting the number of distinctive features in common (col 11, lines 1-14: calculating the ratio C/T inherently shows counting the number of distinctive features in common C)
- comparing the overlap ratio to a threshold and if the overlap ratio is greater than the threshold, then the pair of documents are duplicates or near-duplicates, otherwise the pair of documents are not duplicates or near-duplicates (col 11, lines 15-46: "if C/T is less than the threshold (e.g. a predetermined parameter), the matches associated with the retrieved document are discarded ..." the fact that the matches are discarded if C/T is less than the threshold and only documents having an interesting or significant number of matches with the current document are retained suggests that the document having an significant number of matches with the current document have the *overlap ratio C/T greater*

than the threshold, which means these documents are similar or duplicates to the current document, otherwise they are not)

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Aiken into Gomes since Aiken teaches calculating the ratio C/T for determine the similarities or duplicates of documents providing the advantage of apply Aiken's calculating method for effectively determining the duplicates of the documents.

10. Claims 8-9 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Gomes as applied to claim 1 above, and further in view of Armstrong (US Pat No. 6,356,633 B1, 3/12/02, filed 8/19/99).

Regarding claims 8 and 9, which are dependent on claim 1, Gomes does not disclose that the method is applied to matching an email message with responses to the email message, and is to matching responses to an email message with the email message. Armstrong discloses an email system that can access a database containing data and information related to predefined keyword lists, predefined response templates, predefined responses, etc., where the *keylists can be matched with the content of the fields associated with the email, such as the "TO", "FROM", "RE", date/time created, date/time sent, date/time received, and of course, the body of the email message itself* (col 5, lines 7-18, figure 2A, 3A-B).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Armstrong into Gomes since Armstrong discloses using the matching of keylists and the content of the email fields to detect the relationship between an email message and its response via the content of fields for sending and receiving message, thus motivating to utilize the document duplicate features of Gomes, where the duplicate features imply *matching of the documents based on a distinctive feature related to keywords in a query*, for matching an email and the response to the email and vice versa.

Allowable Subject Matter

11. Claims 22-25, 31-36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

12. Applicant's arguments filed 8/26/04 have been fully considered but they are not persuasive.

Applicants argue that Gomes does not represent prior art and should be withdrawn from consideration since the present application was conceived prior to the filing date of the provisional patent application underlying the Gomes patent and was diligently reduced to practice through the filing date of the present application as having sworn behind the declaration filed 8/26/04 (Remarks, page 12).

Examiner respectfully disagrees.

Though Applicants submitted the declaration to swear behind that the present application was conceived prior to the filing date of the provisional patent application underlying the Gomes patent and was diligently reduced to practice through the filing date of the present application, the declaration was ineffective to overcome the Gomes reference as addressed in the response to the declaration.

Applicants also argue that Gomes does not disclose the claimed invention since the claims are amended. In particular, independent claims 1, 37, and 39 now further include the limitations "wherein the distinctive features are text fragments, which are sequences of at least two words that appear in a limited number of documents in the document collection, wherein the text fragments are determined to be distinctive features based upon a function of the frequency of a text fragment within a document in the large collection of documents." However, the added limitations are nothing new. They are the limitations of claims 13, 17, and 19, which are rejected in the previous office action, now are canceled.

Gomes, thus, still discloses the claimed invention.

Response to Amendment

13. The declaration filed 8/26/04 under 37 CFR 1.131 have been considered but are ineffective to overcome the Gomes reference (6,615,209).

Art Unit: 2178

14. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Gomes reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

Regarding conception, the declaration does not support the claimed limitations. *An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. Ex parte Ovshinsky*, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989). See MPEP 715.07.

Also, the declaration, though shows that the invention was complete on 6/24/99, the declaration does not show the correspondence between the elements of the claims and the evidence presented in Exhibit 1. "[C]onception is established when the invention is made sufficiently clear to enable one skilled in the art to reduce it to practice without the exercise of extensive experimentation or the exercise of inventive skill." *Hiatt v. Ziegler*, 179 USPQ 757, 763 (Bd. Pat. Inter. 1973). *Conception must be proved by corroborating evidence.*; *Hybritech Inc. v. Monoclonal Antibodies Inc.*, 802 F. 2d 1367, 1376, 231 USPQ 81, 87 (Fed. Cir. 1986). See MPEP 2138.04.

15. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Gomes reference to either a constructive reduction to practice or an actual reduction to practice.

Regarding due diligence, Applicants must show how the evidence supports the diligence from prior the effective date of the reference to the filing date of the application. *An applicant must account for the entire period during which diligence is required. Gould v. Schawlow, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.) An applicant must account for the entire period during which diligence is required. Gould v. Schawlow, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.)* Though the declaration provides a timeline with details of the facts where the invention had been prepared since 5/28/99, prior the effective filing date of Gomes 2/22/00, to the filing date of the invention 11/15/00, there are gaps between the evidence document **without explanation**. For example, there are **gaps of almost 3 weeks** from 5/28/99 to 6/24/99, and from 8/25/99 to 9/15/99, **gaps of two weeks** from 10/13/00 to 10/27/00, **gaps of over one month** from 9/17/99 to 11/19/99, and from 12/10/99 to 2/11/00, **gap of over 3 months** from 6/27/00 to 10/10/00, and **gap of over 4 months** from 2/11/00 to 6/22/00, **all without explanation**. *In re Harry, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing*

but a mere pleading). A 2-day period lacking activity has been held to be fatal. In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); Kendall v. Searles, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.). The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. Rebstock v. Flouret, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); Rieser v. Williams, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent's entry into the field); Griffith v. Kanamaru, 816 F.2d 624, 2 USPQ2d 1361 (Fed. Cir. 1987) (Court generally reviewed cases on excuses for inactivity including vacation extended by ill health and daily job demands, and held lack of university funding and personnel are not acceptable excuses; Anderson v. Crowther, 152 USPQ 504, 512 (Bd. Pat. Inter. 1965) (preparation of routine periodic reports covering all accomplishments of the laboratory insufficient to show diligence). See MPEP 2138.06.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Messerly et al. (US Pat No. 6,246,977 B1, 6/12/01, filed 8/3/99).

Corston-Oliver et al. (US Pat No. 6,295,529 B1, 9/25/01, filed 12/24/98).

Boguraev et al. (US Pat No. 6,353,824 B1, 3/5/02, filed 11/18/97).

Davies et al. (US Pat No. 6,353,827 B1, 3/5/02, filed 9/22/98).

Stalcup et al. (US Pat No. 6,741,743 B2, 5/25/04, filed 7/31/98).

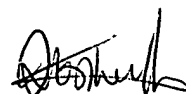
Art Unit: 2178

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Clh
3/3/05



STEPHEN HONG
SUPERVISORY PATENT EXAMINER